

REMARKS

This patent application presently includes Claims 1-52 and 58-67, of which Claims 1-52 and 58-62 are rejected and Claims 63-67 are newly added. Claims 3, 12, 17, 21, 25, 27, 34, and 35 were rewritten in broadened form to eliminate unnecessary limitations. In the case of Claims 3, 25, 34, and 36, they were also rewritten in independent form. Claims 63-67 provide dependent claims which restore the limitations that were eliminated in broadening some of the claims. All rejections are respectfully traversed.

This amendment is accompanied by the declaration of Brad Myers. This is the applicant's response to the examiner's affidavit under 37 C.F.R. 1.104(d)(2). The Myers' declaration is also submitted under 37 C.F.R. 1.132.

On January 16, 2003, the undersigned held a personal interview with Examiner Gravini, at which time the present amendments were proposed and the arguments presented below were offered in favor of allowability. Moreover, the undersigned clearly indicated to the examiner that it was intended to submit the affidavit of an expert in response to the examiner's affidavit. At the conclusion of the interview, agreement was not reached as to the claims being allowed. However, the examiner agreed to give full consideration to all of the arguments and the foreshadowed expert's affidavit.

The Final Rejection Was Premature

Initially, the undersigned wishes to point out that the finality of the last rejection was decidedly premature. In the last office action, the examiner, for the first time, submitted his rejection based upon JUNO in the form of an affidavit setting out detail, which permitted the applicant to completely understand the basis of the rejection and to be able to respond to it. Indeed, 37 C.F.R. 1.104(d)(2) prescribes that the examiner's affidavit "shall be subject to contradiction or explanation by the affidavits of the applicant and other persons." Accordingly, the applicant is entitled to submit the Myers declaration as a matter of right, and the examiner should not arbitrarily cut off prosecution at this critical stage. The examiner will observe that now that the JUNO rejection is understood, some of the claims have, in fact, been broadened. Accordingly, the finality of the rejection is believed to be improper and it should be withdrawn to permit consideration of the present amendment and the declaration as a matter of right.

Rejections Under 35 U.S.C. §112

Claims 1-52 and 58-62 were rejected under 35 U.S.C. §112 as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor had possession of the claimed invention. This rejection is respectfully traversed.

Dr. Myers is on the faculty in the Human-Computer Interaction Institute, School of Computer Science, Carnegie Mellon University. He has been

teaching computer science courses to both undergraduate and graduate students for 14 years. (Myers Declaration, Paragraph 1). Clearly, Dr. Myers is an expert on the technical level of skill of computer science students.

In the paragraph bridging Pages 2 and 3 of the office action, the examiner stated specific features which were allegedly not disclosed in the application in such a way as to reasonably convey to one skilled in the art that the inventor has possession thereof. In Paragraph 3 of his declaration, Dr. Myers addresses this issue directly and concludes that the examiner is incorrect. Specifically, In Paragraphs 3a and 3b, the examiner explains specifically how those features were disclosed in the application. Moreover, in Paragraph 3c, Dr Myers concludes that all of the subject matter would be understood by and is well within the level of skill of an undergraduate student in computer science.

In the paragraph bridging Pages 2 and 3 of the office action, the examiner also rejects Claims 7, 10, 19, 20, 29, 32, 38, 41, 46, 51 and 62 as not enabling. In Paragraph 4 of this declaration, Dr. Myers specifically addresses each of these grounds of rejection and, in Paragraph 5, he again concludes that the examiner is wrong as to the features discussed in Paragraph 4a of the declaration. Furthermore, that paragraph specifically explains how and where in the application an enabling disclosure is provided in the present patent application. Dr. Myers opines that an undergraduate student in computer science could easily realize the features disclosed in Paragraph 4a of the declaration based upon the disclosure of the present patent application.

In Paragraph 6 of the Myers Declaration, Dr. Myers also disagrees with the examiner's conclusion as to the subject matter set forth in Paragraph 4b of the declaration. Moreover, Dr. Myers specifically sets forth where and how the present patent application provides an enabling disclosure. In addition, Dr. Myers points out that the examiner himself seems to admit that this subject matter is well known in the art, in his reference to the JUNO system in the affidavit. Thus, the examiner has taken an inconsistent position as to enablement between making this rejection and his affidavit. As to the nature of subject matter, Dr. Myers attests that an undergraduate student would be well aware of how use a "tag" and would not require any specific teachings about the technique.

At the paragraph bridging Pages 2 and 3 of the office action, the examiner asserts that the lack of user control is considered new matter, because the user always has control of a computer and one skilled in the art would not be able to enable an uncontrollable computer. Since this subject matter is presented in an original claim, it has been assumed that the examiner actually intended to assert lack of enablement.

In Paragraph 7 of his declaration, Dr. Myers addresses this point directly. He specifically states his opinion that anyone of ordinary skill in computer science, including an undergraduate student, would understand that "completely beyond the user's control" refers to "said character" and not the computer. More specifically, Dr. Myers states that those skilled in the art would realize from this claim language that character is intended to be beyond the user's control while the application program is running, from the clear context of the claim. Dr. Myers notes that interpreting this

language to mean that the computer must be beyond the user's control would be nonsensical, as well as technically impossible (as noted by the examiner), since the user can always turn off the computer or disconnect it from the power source.

In Paragraph 2, starting at Page 3 of the office action, the examiner rejects Claims 1-52 and 58-62 as indefinite, because the application allegedly fails to provides an antecedent basis for the claimed subject matter. Claims 7, 10, 19, 20, 29, 32, 38, 41, 46, 51 and 62 were also separately discussed. It is believed that Dr. Myers' testimony with respect to the other 35 U.S.C. §112 rejection is adequately responsive to this rejection as well. Specifically, Dr. Myers pointed out all the ways in which the present application provides sufficient disclosure, and therefore an antecedent basis for the claimed subject matter.

For all of the above reasons, all of the rejections under 35 U.S.C. §112 are clearly improper and should be withdrawn.

Rejections Under 35 U.S.C. §102

At the interview, the examiner appeared to appreciate the appropriate effective filing date to be accorded to the present application. Specifically, the undersigned will state for the record that the present application is a continuation of a PCT application designating the United States and also claims the priority of a provisional patent application filed within a year prior to the PCT application. The present application is therefore entitled to the filing date of the provisional application with respect to any prior art that the examiner might cite. That date is

November 11, 1999. Any patent cited under 35 U.S.C. §102(b) must therefore have a date prior to November 11, 1998, and any patent cited under 35 U.S.C. §102(e) must have a filing date prior to November 11, 1999.

The examiner is correct that the recent revision to 35 U.S.C. §102(e) made 102(e) prior art effective against all patent applications, including those filed before November 29, 2000. However, the revision does not apply to PCT applications filed before November 29, 2000. For those, the earliest date available as a reference is the PCT publication date. None of the PCT applications cited by the examiner was published prior to November 11, 1999. Thus, none of them are prior art with respect to the present application. These references will not be discussed further. Instead, we will proceed to the discussion of the 35 U.S.C. §102 rejections based upon U.S. patents.

In Paragraph 9 of his declaration, Dr. Myers sets forth three broad concepts of the present invention that he considers to be unique. First, the character appears on the screen display or window of the application program in a way that prevents him from controlling it. Second, the character appears intrusively in a manner which is unpredictable to the user. Third, the character is completely beyond the user's control.

In Paragraph 10 of his declaration, Dr. Myers opines that although the patents to Petrecca, Reilly and Schena do relate to advertising systems on computers and networks, they bear no relationship to introducing a character in the window of an application program with any of the features described above.

It is noted that all of the features referred to by Dr. Myers in Paragraph 9 of this declaration are features of the inserted character. The examiner appears to be treating those features as an intended use. However, nothing could be further from the truth. Those are features of a "physical" character inserted into a "physical" display of an application program. There can be no justification for ignoring those features. Moreover, the examiner has merely asserted that characters with those features are disclosed in Petrecca, Reilly and Schena. Indeed, none of these references even suggests insertion of a multimedia animated character, much less one with any of the features pointed out by Dr. Myers. If the examiner disagrees, it is requested that he specifically point out where those references even suggest such character or that the character have any of those features.

In Paragraph 11 of his declaration, Dr. Myers opines that the Cohen patent bears no relationship to introducing a character in the display of an application program and that it does not have the slightest relationship to achieving a character with any of the distinctive features he described previously.

In Paragraph 12 of his declaration, Dr. Myers notes that the Wexler patent merely discloses the use of banners which, he notes, the present application indicates as undesirable. He similarly finds the Albert patent to relate to banners as well and not to disclose any of the unique features of the present invention. He concludes by totally disagreeing with the examiner that either of these references could possibly anticipate the presently claimed invention, which is intended to be

entirely different from banners and to appear unpredictably and unlike banners, out of the user's control.

In Paragraph 5 at Page 5 of the office action, the examiner rejects all of the claims in this application based upon an alleged public use. This is based upon information which the examiner found in the assignee's website which states that the present concept was created in 1999. On some basis, the examiner finds this to be a public use. However, even if that were the case, the effective filing date of the present invention is November 11, 1999. This is consistent with the discussion on the website. Moreover, since the examiner is alleging a public use by the applicant or his representative, that use would have to be prior to November 11, 1998 in order to be a statutory bar. This rejection should be withdrawn.

Rejections Under 35 U.S.C. §103

Claims 1-52 and 58-62 were rejected as obvious over JUNO online services as set forth in the examiner's affidavit.

This issue is addressed in Paragraph 13 of the Myers declaration. He refers to this type of advertisement as "Pop-up advertisement." He notes that when such advertisement is presented to a user observing the display of an internet page, the pop-up advertisement does not appear in the display of the page of the application program (e.g. the browser) that the user is observing. It appears in a separate window. He further notes that such windows are not out of the user's control, but can easily be closed or moved. He contrasts the multimedia character of the present invention, which is in the same display or window as the internet page and is out of the user's control.

He also notes that, since pop-up advertisement is in a separate window, it remains on the user's display even after the browser is closed. The user would then have to close each pop-up window separately.

Dr. Myers summarizes his position in Paragraph 14 of the declaration stating that the JUNO pop-up advertisement does not meet the claim description of the present invention, because it is not out of the user's control and because it does not appear in the same screen display or window as the application program.

Accordingly, it is eminently clear that the obviousness rejection is improper and should be withdrawn.

In making his rejection, the examiner states that "the introducing or display into a compute screen of a multimedia animated character would be performed the same regardless of the nature of the character", that "all pop-up advertisements are intrusive, unpredictable and uncontrollable" and "this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability." From Dr. Myers' declaration and the preceding discussion, the examiner, no doubt, understand that introduction of the character in accordance with the present invention is quite different from pop-up advertising, in that the character is introduced into the display of the program or the same window as the program. This is not simply descriptive language, but a physical difference of how and where the character is introduced. Furthermore, although pop-up advertisement is intrusive and unpredictable, it is certainly not uncontrollable, since the user can simply close the pop-up window, move it, or place something else on

top of it. Again, this is not merely a descriptive difference, but a physical difference exhibited by the invention. The examiner must also appreciate that simple pop-up advertisements could never achieve the physical features of the inventive advertising which are presented in the claims.

For all of the above reasons, the obviousness rejections are improper and should be withdrawn.

Turning now to the claims as they are presently constituted, Claims 1, 2, 23, 24 and 39-48 and 50 include the feature that the character is introduced in a manner which is completely beyond the user's control. This feature has been deleted from independent Claims 3, 12, 21, 25, 34, 36, 49, in order to broaden those claims, but it has then been added back by one of the newly added dependent Claims 63-67. As indicated above, this is one of the unique features of the present invention.

Independent Claim 3 provides that the character is located in the uppermost layer of the application program window, Claim 12 provides that the character is produced in the client's computer display of the content, Claim 21 provides that the character appears on the content, Claim 25 provides that the character is located in the uppermost layer of the application program window, and Claim 34 provides that the character is located in the uppermost layer of the application program window. As explained above, providing character in the display of the application program, whether it be displayed on the top layer or simply on the content, is a unique feature of the present invention.

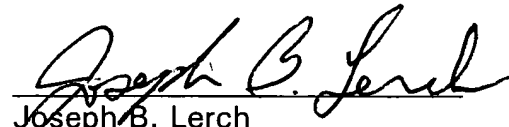
Independent Claim 49 and independent method Claim 36 provide that the character overlies an existing image produced on the screen by the application program and that a portion of the character is transparent so that a portion of the existing image can be seen through it. This structure describes a way to make the window of the inserted character have the odd shape of the character itself rather than the rectangular shape of a window. At the interview, the examiner agreed that this is a novel feature of the present invention.

Above, it has been shown that every independent claim in the present application has at least one unique feature that makes the claim patentable. The remaining claims depend from one of these claims and are believed to be allowable owing to their dependence from an allowable claim. However, many of the dependent claims add further features not taught or suggested by the prior art and are believed to be allowable on their own merits. In summary, all of the claims are now in condition for allowance.

Applicant's attorney has made every effort to place this patent application in condition for allowance. It is therefore earnestly requested that the present amendment be entered, that the application, as a whole, receive favorable reconsideration and that all of the claims be allowed as presently constituted.

Should there remain any unanswered questions, the examiner is requested to call the applicant's undersigned attorney at the telephone number given below.

Respectfully submitted,


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